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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,216	03/29/2004	Luke Aram	1671-0295	3037
28078	7590	07/25/2008		
MAGINOT, MOORE & BECK, LLP				
CHASE TOWER	EXAMINER			
111 MONUMENT CIRCLE	ARAJ, MICHAEL J			
SUITE 3250	ART UNIT	PAPER NUMBER		
INDIANAPOLIS, IN 46204		3733		
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		07/25/2008	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/812,216	<b>Applicant(s)</b> ARAM ET AL.
	<b>Examiner</b> MICHAEL J. ARAJ	<b>Art Unit</b> 3733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 08 November 2007.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-21 and 30-36 is/are pending in the application.

4a) Of the above claim(s) 37-44 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-21 and 30-36 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 29 March 2004 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_

**DETAILED ACTION**

The arguments filed on November 8, 2007 have been partially persuasive. Due to this finding the Final rejection mailed June 6, 2007 has been withdrawn.

***Election/Restrictions***

Newly submitted claim37-44 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the apparatus as claimed can be used in a different process, e.g. in a method that does not require the removal of a resected first portion of the bone.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 37-44 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 30 is rejected under 35 U.S.C. 102(b) as being anticipated by Hitt (Reference U.S. Patent "5,077,902").

Hitt discloses a wire saw (24); a saw driver including a shaft (23a), a body (8) coupled at a first end to the shaft to be rotated, the body including a second end formed to include teeth (please see response to arguments), the wall being formed to include a driver surface (col. 2, lines 38-68 and col. 3, lines 53-61).

With regards to the statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Hitt (i.e. "adapted to be driven by a rotary drill to rotate about an axis"), which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). Furthermore, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 and 30-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mains et al. (U.S. Patent No. 4,421,112) in view of Haines (U.S. Publication No. 2006/0030854).

Mains et al. (herein Mains) discloses a guide system comprising: a first and second alignment pin (12); and wherein the first and the second alignment pin (12) are configured and oriented to define a resection of reference (col. 2, lines 8-38). The first and second alignment pin (12) has a length sufficient that the first and second alignment pin (12) extends completely through the bone with one tip extending beyond the bone on the first side and the second tip extending beyond the bone on the opposite side (col. 4, lines 27-33). The resection surface of reference is a plane (col. 4, lines 57-68). The apparatus further comprises a guide block formed to include a first and second guide hole (col. 2, lines 51-54). The first and second guide hole being sized to receive a drill sized to form a hole in the sized to receive the first and second alignment pin. The second guide hole oriented with respect to the first guide hole to define a plane (col. 2, lines 54-67). The guide block is formed to include a first and a second guide saw guide (see Figure 1 below). The first alignment pin (12) is received in the bone and the first guide hole and the second alignment pin (12) is received in the bone and the second guide hole (col. 5, lines 4-34). The guide block is formed to include a third guide hole extending through the block, sized to receive a drill sized to form a hole, and a third

alignment pin (col. 3, lines 35-44). The apparatus further comprises a saw driver (col. 5, lines 48-49).

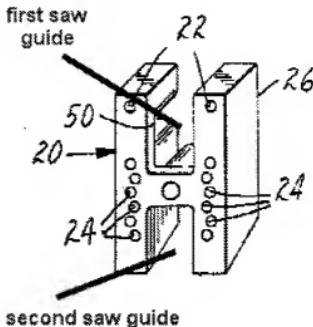


Figure 1

Mains disclose the claimed invention except for the wire saw; a saw driver configured to be guided by the first pin through the bone and to drive the saw guided by the saw driver and the second alignment pin through the bone; and fingers attached to the shaft. Haines teaches to provide a cutting wire having sufficient tensile strength when drawn into a small diameter in order to present a thin cutting profile. Haines also discloses the saw being guided from a first pin to a second pin (see Fig. 61) as well as fingers providing tension (see Fig 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Mains having a wire saw, in view of Haines, in order to reduce implant placement errors

in order to create more reproducible and consistently excellent clinical results that is less dependent on manual skills of the surgeon (Paragraph 13).

Claims 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mains et al. (Reference U.S. Patent "4,421,112", as cited in IDS).

Mains et al. discloses the claimed invention except for the first and second alignment pins and the wire saw being configured to be inserted through incisions less than six centimeters long; less than about two centimeters long; and about one centimeter long. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Mains with the first and second alignment pins configured to be inserted through incisions less than six centimeters long, less than about two centimeters long and about one centimeter long, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

#### ***Response to Arguments***

Applicant's arguments, see appeal brief, filed November 8, 2008, with respect to claim 13 have been fully considered and are persuasive. The rejection of claim 13 has been withdrawn.

Applicant argues, with respect to claim 30, that a driver separate from a wire saw to include bone cutting teeth on one end of the body. From interpretation of the claim, it

is not required for these to be separate. All that is required in reference to the teeth is that "the body including a second end formed to include teeth". Hitt clearly shows teeth formed in a second end (where the wire saw is). It is not specifically stated that the teeth of a driver be separate from the wire saw.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL J. ARAJ whose telephone number is (571)272-5963. The examiner can normally be reached on M-F 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael J Araj/  
Examiner, Art Unit 3733  
/Eduardo C. Robert/

Supervisory Patent Examiner, Art Unit 3733